

Application No. 09/575,845
Reply to Office Action dated August 2, 2004

REMARKS

Claims 1-62 are currently pending in this application. Claims 1-3, 5-6, 15, 18-20, 22-23, 32, 37, 39-40, 42, 44-45, 47, 49, 52, 54, 57, and 59-62 have been amended. Claims 38 and 43 have been canceled. No new matter has been added.

Applicant's representative expresses gratitude to the Examiner for his time and effort extended in a recent telephone interview conducted on October 7, 2004.

Consistent with that interview, applicant has amended the claims to incorporate the ideas discussed therein, namely to clarify that applicant's claims are directed to the displaying of and determining of selection between two or more trade or service marks to activate application-specific commands, such as commands that cause a shopping list to be printed or a logout procedure to be initiated, in order to track consumer awareness or preference of one trade or service mark relative to another. In view of the further remarks below that distinguish the prior art of record, applicant respectfully requests reconsideration of these claims and timely entry of these amendments.

Rejections Under 35 U.S.C. §101

The Examiner has continued to reject claims 37-41, and 47-51 under 35 U.S.C. §101 because, as he asserts, the phrase "in a computer system" in the respective preambles is insufficient to indicate that the recited acts of the method are performed by a computer system. Although applicant continues to disagree and respectfully asserts that the law does not require method claims to explicitly incorporate the structure of a computer system into the body of the claims to comprise acts that are performed by a computer system, applicant has amended claims 37 and 47 to recite "displaying on a display device" and claims 37 to additionally recite "a shopping list displayed on the display device" in the interest of advancing prosecution. Accordingly, applicant respectfully requests the Examiner to withdraw the §101 rejections.

Rejections Under 35 U.S.C. §102

The Examiner has rejected all of claims 1-62 over the Barnett reference (U.S. Patent No. 6,321,208 issued to Barnett et. al.). In essence, the Examiner "equates a coupon or

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coupon package, as disclosed by Barnett, to a mark or a symbol or graphical image representing a promotion associated with a product or service or brand name from a manufacturer or a retailer" and asserts that, since Barnett's "online service provider can also determine how many times a particular coupon was viewed, selected, printed or used," Barnett teaches applicant's determining a frequency of selection as recited in applicant's claims 1-62. Applicant respectfully disagrees.

In summary, all of applicant's independent claims 1, 15, 18, 32, 37, 42, 47, 52, 57, and 60-62, before and after amendment, are directed to the use of "brand-related trade or service marks" to activate a command – specifically printing a shopping list or initiating a sign-off from the application (or a logout command). The frequency of such *activation*, as measured by selection of one mark relative to another, is then used as the metric to determine brand recognition or consumer awareness.

Applicant has amended the claims to clarify that the brand-related marks represent *alternative* activation mechanisms, so that the selection of one mark over the other is indicative of consumer awareness or brand recognition.

For example,

- claims 1, 18, 42, and 60 recite:
displaying at least two brand-related marks as activation mechanisms to print a shopping list;
which have been amended to recite,
displaying at least two brand-related trade or service marks as *alternative* activation mechanisms to print the displayed shopping list" or similar language;
- claims 15, 32, and 61 recite:
retrieving an ... accounting of past activations of the at least two marks used to print a shopping list or to execute a logout command; and
determining a frequency of selection of one of the at least two marks relative to another one of the at least two marks;
which have been amended to recite,
retrieving an ... accounting of past activations of the at least two marks used to print a shopping list or to execute a logout command; and

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based upon the accounting of past activations, determining a frequency of selection of one of the at least two marks relative to another one of the at least two marks, thereby measuring consumer awareness...; or similar language;

- claims 37 and 62 recite:

displaying at least two brand-related marks as activation mechanisms to print a shopping list; and
receiving and indication of a selected ...

which have been amended to recite,

displaying at least two brand-related trade or service marks as *alternate* activation mechanisms to print a shopping list; or similar language; and

- claims 47, 52, and 57 recite:

displaying a plurality of brand-specific marks, which, when selected, initiate an application-specific command to print a shopping list or to initiate sign-off from the application; and
measuring brand recognition by tracking a frequency each... [mark] is selected to initiate the command;

which have been amended to recite

displaying a plurality of brand-specific trade or service marks, which, when selected, *activate* an application-specific command to print a shopping list or to initiate sign-off from the application; or similar language; and

measuring brand recognition by tracking a frequency each... [mark] is selected to *activate* the application-specific command.

A similar analysis can be performed on the recited language that determines relative consumer awareness or measures brand recognition based upon tracking the number of times or frequency each trade or service mark is used to activate a command.

Nowhere in Barnett is there any teaching of using a displayed service mark or a trade mark to activate the printing of a shopping list or to logout from the application, let alone using the frequency of such activation to track brand recognition as recited by the above phrases of applicant's claims. Rather, Barnett teaches that a shopping list is printed by using the "shopping list function button 58" which "calls the shopping list generation routine 32g when selected by the user." (Barnett, 10:17-18.) Coupons can be selected for viewing, printing coupons etc. – they are not used to activate printing the shopping list as claimed by applicant. (Coupons are merely "clipped" to be included in the shopping list produced by selecting the

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shopping list function button.) *Barnett*, 9:59-63. Also, there is no teaching in *Barnett* using any mechanism to activate a logout command. Thus, there is absolutely no mention in *Barnett* of "determining a frequency of selection of one of the at least two marks relative to another" or "consumer awareness of the at least two marks relative to each other" where the marks have been used to activate printing or to execute a logout command. *Barnett* simply does not teach, motivate, or suggest the limitations of applicant's independent claims and hence all of the dependent claims that depend therefrom. Therefore, claims 1-62 are not anticipated by or obvious in view of *Barnett*, and should be allowable.

In addition, several of the dependent claims present limitations that are not present in any of the cited prior art. Specifically, claims 6 and 23 are directed to an "enticement" that "is associated with the at least two marks" to cause someone to "select a mark." Given that these "at least two marks" are the trade or service marks used for the specific purposes recited in the independent claims (see analysis above), the enticement is associated with the at least two marks and is thus used to entice the user to use one of the marks (rather than the other) for activating printing of the shopping list or logging out. There is no discussion of any "enticement" (advertising or otherwise) in *Barnett* for selected any particular object relative to another object, where the objects are used to activate printing or to log out of the system. In addition, claims 7-14 and 24-31 recite one or more "~~profit-sensitive~~ giveaways" associated with these "at least one of the at least two marks" and further limitations as to how such giveaways operate. There is no mention in *Barnett* of these recited aspects, including any type of advertising that is profit-sensitive. Thus, *Barnett* simply does not teach, motivate, or suggest more or more limitations of applicant's dependent claims. Therefore, claims 6-14 and 23-31 are not anticipated by or obvious in view of *Barnett*, and should be allowable for these additional reasons.

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In closing, applicant respectfully requests the Examiner enter these amendments and to reconsider this application and its early allowance. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. Again, applicant's representative thanks the Examiner for his prompt and courteous attention. In the event the Examiner finds minor informalities that can be resolved by telephone conference, the Examiner is urged to contact applicant's representative at (206) 622-4900.

Respectfully submitted,

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